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U.S. Patent and Trademark OfficeFAX NO. (571) 273-8300
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MESSAGE

Please direct this facsimile to patent examiner Alford W. Kindred in Art Unit 2163. This facsimile concerns the following patent application:

Serial No. 09/934,386
Applicant: Vasudevan et al.
Filed: August 21, 2001
Invention: System and Method for Data Replication in a Computer System

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PATENT
016295.0673

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Vasudevan et al.

Serial No.: 09/934,386

Filed: August 21, 2001

Invention: System and Method for Data
Replication in a Computer System§
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Group No.: 2163

Examiner: Alford W. Kindred

**REQUEST TO REISSUE AND WITHDRAW THE FINALITY OF
THE PREMATURE FINAL OFFICE ACTION**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants respectfully request that the patent examiner reissue and withdraw the finality of the premature final office action mailed May 12, 2005 ("the final office action"). Although the final office action is the second office action on the merits, the final office action is premature because it includes a new ground of rejection that was not necessitated by an amendment in response to the previous office action. Specifically, the final office action includes a new ground of rejection (a) that is premised on prior art that was not previously of

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record in the patent application and (b) that was not necessitated by an amendment made in response to the previous action.

A. Factual Background

This application was filed in August 2001. On November 19, 2004, the Examiner issued an office action in this application. As of November 2004, claims 1-31 were pending in this application. In the November 2004 office action, the Examiner rejected claims 1-31 as being obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 6,438,594 to Bowman-Amuah in view of U.S. Patent Application Publication No. 20010049717 to Freeman.

In response to the November 2004 office action, the applicants filed a response. In the response, the applicants cancelled claims 3 and 4 and incorporated the elements of claims 3 and 4 into claim 1. The applicants also cancelled claims 24 and 25, and incorporated the elements of claims 24 and 25 into claim 23. Following this amendment, amended claim 1 is a rewrite of claims 1, 3, and 4, and amended claim 23 is a rewrite of claims 23, 24, and 25. Shown in the chart of Exhibit A is a comparison of claims 1, 3, and 4, and claims 23, 24, and 25, as these claims existed before and after the response to the November 2004 office action. (The portions of the former dependent claims that have been incorporated into the remaining independent claim have been italicized and underlined). As can be readily seen from the chart of Exhibit A, the limitations of cancelled claims 3 and 4 now appear in amended claim 1, and claim 1 is not otherwise substantively changed. It can also be readily seen that the limitations of cancelled claim 24 and 25 now appear in amended claim 23, and claim 23 is not otherwise substantively changed.

The examiner issued a final office action in May 2005. In the final office action, the examiner rejected claims 1 and 23 under 35 U.S.C. § 103(a) over Bowman-Amuah in view of

Freeman and U.S. Patent No. 5,781,908 to Williams et al. Thus, Williams is a new ground of rejection. Williams was not introduced as prior art by the Examiner until the final office action. Thus, to overcome the limitations of claims 1 and 23, the examiner asserted a rejection that employs a new ground of rejection. This new ground of rejection of these claims was not necessitated by amendment, as claims 1 and 23 include the limitations of cancelled claims 3, 4, 24, and 25, respectively.

B. Because the New Basis for the Rejection of Claims 1 and 23 Was Not Necessitated by Amendment, the Finality of the Pending Office Action is Premature and Should be Withdrawn

A second or later office action cannot be final if a new ground of rejection is asserted in the second office action that is not necessitated by the applicant's amendment of the claims. Manual of Patent Examining Procedure 706.07(a). Here, a new ground of rejection has been asserted with respect to claims 1 and 23, and this new ground of rejection includes new art — Williams — that was not a previous basis for the rejection and was not previously cited as art of record.

This new ground of rejection was not necessitated by amendment. The amendment simply incorporated the elements of claims 3 and 4 into claim 1, and the elements of claims 24 and 25 into claim 23. As such, it cannot be argued that these amendments necessitated the addition of Williams, as the limitations of dependent claims 3, 4, 24, and 25 were previously present in the application.

Because the pending office action includes a new ground of rejection not necessitated by amendment, the applicants should not be placed in the position of having to respond to a final office action. In their response to the first office action, the applicants successfully demonstrated to the Examiner that the limitations of claims 3, 4, 24, and 25 were not

disclosed by the combination of Bowman-Amuah and Freeman. The applicants should not now be forced to respond to the newly cited art from the procedural posture of a final office action, where the ability to amend claims to put them in condition for allowance is limited. Because a new ground of rejection not necessitated by amendment is asserted in the final office action, fairness and the established rules of practice require that the finality of this rejection be withdrawn.


B. Because the Final Office Action Includes Errors and Does Not Address Each Claim of the Pending Office

The final office action attempts to address and provide analysis concerning claims 1-31. The final office action does not, however, recognize that claims 3, 4, 21, 22, 24, and 25 have been cancelled by amendment. Because the final office action does not correctly categorize each pending claim of the application, the applicants respectfully request that the final office action be reissued.

Conclusion

Because of the premature nature of the finality of the pending office action, the applicants respectfully request that the Examiner withdraw the finality of the pending office action and *reissue* the office action as a non-final office action. Applicants request that the Examiner respond to this request at his earliest possible convenience.

Respectfully submitted,



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Baker Botts Docket Number: 016295.0673

Date: September 7, 2005